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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,540	06/26/2001	Tony Mastronardi	871-102	9380

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EXAMINER
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HUYNH, BA

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/888,540

Applicant(s)

MASTRONARDI, TONY

Examiner

Ba Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawing corrections filed on 8/31/04 have been approved by the examiner.

### *Terminal Disclaimer*

2. The terminal disclaimer filed on 8/31/04 has been recorded.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 (previously 14-17) are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,963,916 (Kaplan), in view of US patent #5,949,411 (Doerr et al).

- As for claim 1: Kaplan teaches a musical kiosk comprising:

a kiosk device including a microprocessor, a local computer memory that maintain a database of digitized songs of various artists and related graphical items corresponding to album covers associated with each the digitized songs, a display for displaying video, an audio arrangement providing audio, a communication system for enabling the musical kiosk to communicate with an audio and graphic distribution network, and a multitasking operating system that enables simultaneous operation of the

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microprocessor, the display, the audio arrangement, and the communication system, wherein the musical kiosk is operable to play the digitized songs from the local memory in response to a user's request, and wherein the musical kiosk is provided with a registration procedure that check whether the musical kiosk has been registered to play songs stored in the local memory (see Summary of the invention; figure 2), and

a server maintaining a master database 60 remote from the kiosk and accessible by the kiosk for downloading stored songs and graphics to the kiosk,

a touchscreen interface for selecting song and displaying of songs and graphical item corresponding to the selected song (figures 11-14),

a display screen for displaying album covers and scroll buttons for scrolling the display (figures 17-18),

wherein upon touch selection of a displayed album, the system displays the selected album cover 255, a list of songs 260-264 associated with the displayed cover wherein the list of available song is less than all the songs exist on the album (see explanations of sampled tracks 260-264 and track list 257), selectable graphical item 258 for displaying any additional album covers of the same artist as the selected album cover.

The registration process and checking of registration is inherently included in Kaplan's teaching of establishing telecommunication link to the network (4:219-31) and access control (10:19-50). Kaplan fails to clearly teach the playing of a selected song responsive to a fee collection. However, in the same field of musical kiosk, Doerr teach that the musical kiosk can be combined with a jukebox thereby eliminating the necessity of manually changing music selections in the jukebox (Doerr's col. 1, lines 35-41). Thus

it would have been obvious to one of skill in the art, at the time the invention was made, to combine Kaplan's teaching of interactive musical kiosk to a jukebox system.

Motivation of the combining is for the advantage of eliminating the necessity of manually changing music selections in the jukebox as clearly taught by Doerr. In light of the combining, the combined kiosk and jukebox would play a selected song responsive to a fee collection.

- As for claim 2: The user interface is operable, by activating button 258, to display graphical items representing any additional album covers of the same artist as the selected album cover for which song exist on the local computer memory (13:32-46).
- As for claim 3: Upon selection of a displayed additional album cover of the same artist, the user interface is operable, by activating Album Preview, Back Track, and Related Albums buttons to display the newly selected cover, a list of song on the local computer memory that exist on the album represented by the newly selected album cover of the same artist as the newly selected album cover for which song exist on the local computer memory.
- As for claim 4: Figure 17 display up to a predetermined number of additional covers of the same artist from a list of additional album covers, and UP/DOWN button for scrolling through the list of additional album cover.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

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5. The applicant had been previously informed that the applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US patent #5,734,719 (Tsevdos et al), see explanation of figures 18-28.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ba Huynh  
Primary Examiner  
AU 2173  
12/28/04

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PRIMARY EXAMINER